

**REMARKS**

The specification is amended herein to correct typographical errors. Specifically, the amendments to the text of the disclosure are supported by Tables 3 and 6 for the Emulsion-A series, Tables 4 and 7 for the Emulsion-P series, Tables 5 and 8 for the Emulsion-J series, Tables 10 and 11 for the Emulsion-X series, Tables 12 and 13 (page 461) for the Emulsion-Y series and Tables 14 and 15 for the Emulsion Z-series.

In more detail, for the Emulsion-A series, the preparation method of Em-A6 is amended to indicate that Em-A6 was prepared based on Em-A5. This means that Em-A6 was amended to contain the compound (I-13), which is within the scope of formula (I), and which was also added to Em-A5 (see page 372, lines 2-6).

In the three Groups of claims in accordance with the Restriction Requirement imposed by the Examiner, i.e., claims 1-5 (Group I), claims 6-15 (Group II) and claims 16-20 (Group III), the compound represented by formula (I) is commonly recited. So, in the Tables of Examples of the present specification all of the samples containing the compound represented by formula (I) in combination with another compound meeting the requirement of claim 1, 6, or 16 are indicated as “Inv.”

According to the data provided for Sample 113 in Table 3 (page 453), in which Em-A6 is contained, Sample 113 is indicated as “Inv”. Thus, Table 3 provides support for Sample 113, i.e., Em-A6, using a compound represented by formula (I). The data set forth for Sample 113 in Table 6 (page 444) of the specification also supports this, because the evaluated values of Sample 113 are superior to those of Sample 112, in which compound (I-13) is added, but the

compound (IX-2-3) is not added. This compound, (IX-2-3) is within the scope of the reducing compounds represented by formulae (VI) to (XI). (See page 255, lines 1-4).

The Em-P, Em-J, Em-X and Em-Z series are similarly supported.

Tables 3, 5, 6 and 8 are amended in accordance with the scope of the elected invention recited in Group I, claims 1-5. The corrected samples, for example, Samples 103 and 104 in Table 3 do not use a compound represented by formula (II), and thus are outside the scope of claim 1. Samples 103 and 104 using compound A-1 (see page 227) are within the scope of claim 6 (Group II) as filed, which are withdrawn from consideration. Other corrected samples, for example, Samples 310-314 in Table 5 do not use a compound represented by formula (II), and thus are outside the scope of claim 1. Samples 310-314 using compound (IV-2) (see page 393, lines 7-12) are within the scope of claim 16 (Group III) as filed.

Claims 1, 6 and 16 are amended to correct a minor informality. Claims 6-20 are withdrawn from consideration in view of Applicants' election to prosecute claims 1-5 of Group I in response to the restriction requirement imposed by the Examiner. New claim 21 is added herein. Support for claim 21 is found for example, on page 139, line 18 to page 140, line 4, page 150, lines 2-3 and page 176, line 23 to page 177, line 4.

Hence, no new matter is presented herein.

Accordingly, upon entry of the Amendment, claims 1-5 and 21 will be all of the claims pending for examination before the Examiner.

**I. Priority**

Applicants note that box 13 of the Office Action Summary Sheet is checked indicating that none of the certified copies of the priority documents have been received.

In this regard, Applicants note the certified copies of the priority documents for the present application were inadvertently filed in co-pending application serial no. 10/926,843. A petition under 37 C.F.R. § 1.59 and MPEP § 724.05 was filed on December 10, 2003, in co-pending application no. 10/026,843 requesting that the improperly filed certified documents be returned so that they can properly be filed in the present application. A Decision on the Petition has not yet been received. In view thereof, Applicants respectfully submit that certified copies of the documents of the present application will be filed in due course upon receipt of the Decision on the Petition mentioned above.

**II. Response to the Rejections of Claims 1-5 under 35 U.S.C. § 103(a)**

Claims 1-5 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over any one of Farid et al (US '253), Gould et al (US '051), Adin et al (US '260) or Adin et al (US '570) in view of Ishii et al (US '750) and Morimoto (US '725).

Applicants respectfully traverse the rejection for the following reasons.

One characteristic feature of the claimed invention as recited in independent claims 1 and new claim 21 is the combined use of the compound represented by formula (I) with a compound represented by formula (II) or (III). The combined use of these compounds attains high sensitivity and low fogging (page 3, lines 11-15) of both fresh materials and after storage under a high temperature and high humidity conditions (50°C, 80%RH; see page 42, lines 16-22).

As the Examiner admits on page 3, lines 7-10 of the Office Action dated September 17, 2003, the primary references do not disclose, teach or suggest the use of a compound represented by formula (II) or (III). Ishi et al describes storage stability (column 2, lines 41-44), but Ishi et al does not describe the property of fogging after storage. (Column 142, lines 50-59).

In this regard, Mr. Hosoya, a co-inventor of the present invention, conducted comparative experiments to demonstrate that the present invention provides unexpectedly superior results when compared to the closest prior art example that are attributable to the combined use of a compound of formula (I) and a compound of formula (II) or (III). The results of the experiments are provided in the Declaration under 37 C.F.R. §1.132, submitted herewith. As shown in Table A of the Declaration, the combined use of the compound represented by formula (I) of the claimed invention and a compound of formula (II) or (III) of the claimed invention greatly suppresses fog after storage under thermal conditions and also greatly suppresses deterioration in sensitivity after storage when compared to the use of a compound of formula (I) without a compound of formula (II) or (III) and the use of a compound of formula (II) or (III) without the use of a compound of formula (I).

With respect to Morimoto, Applicants respectfully submit that Morimoto is commonly owned or subject to an obligation of assignment with the present application by Fuji Photo Film Co., Ltd., and therefore is disqualified as a reference against the present application in accordance with 35 U.S.C. § 103(c).

In view of the above, Applicants submit that the presently claimed invention provides unexpectedly superior results over the prior art and therefore is not rendered obvious.

Accordingly, Applicants respectfully request withdrawal of the rejection.

### III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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